

REMARKS

Applicant respectfully requests reconsideration of the instant application on the basis of newly amended Claims 1 and 8. Claims 1 and 11 are the main claims and the remaining claims are directly or indirectly dependent upon those.

The Examiner has rejected the claims as being unpatentable over U.S. Patent No. 6,150,650 by Bowen et al. (*Bowen*). It is believed that Claims 1 to 18 are clearly distinguishable over this reference for the reasons that will be set forth.

Objections to the Claims

The Examiner objected to Claims 1 and 8 as being vague or lacking an antecedent basis. Presently, Claims 1 and 8 are amended in an effort to address the objections. Applicants respectfully submit that no new matter is added by these amendments. Accordingly, Applicants respectfully submit that these rejections should now be withdrawn.

35 U.S.C. § 102(b) Grounds for Rejection

The Examiner has principally rejected the claims as being anticipated by *Bowen*. It is believed that Claims 1 to 18 are clearly distinguishable over this reference for the reasons that will be set forth.

The *Bowen* reference describes a device and a method for providing user adjustable variable gain for a specific image intensifier tube type mounted within a night vision device. As *Bowen* teaches, an "image intensifier tube is subjected to factory calibration for providing an optimum output during operation, wherein said calibration undersirably differs from tube to tube." Col. 2, lines 48-62.

While *Bowen* teaches that multiple image intensifier tube types exist, *Bowen* fails to disclose that a single night vision device may be adapted to use multiple image intensifier tube types as replacements for the original equipment tube. See Cols. 1-2. *Bowen's* device, unlike that of the present invention, only teaches a night vision device that uses a single tube type and the calibration differs from tube to tube. While the *Bowen* tubes may be changed, the tube types are not changed or replaceable, thereby limiting the usefulness in field use of the night vision devices where the same tube type may not always be available.

Independent Claim 1 recites the following elements, the most pertinent to this discussion being presented in bold type for the convenience of the Examiner:

1. An adaptive electrical circuit unit for use in a night viewer system of the type that includes an image intensifier tube and a compatible power source electrically connected to the image intensifier tube, the invention comprising:
 - a voltage gain detection circuit unit operably connected to the image intensifier tube for detecting **multiple selected types of image intensifier tubes** and producing an output gain signal appropriate to the **detected image intensifier tube** for controlling the gain of the detected image intensifier tube.

Since such use of multiple image tube types in the night vision device of the Applicants' invention as claimed is not disclosed or suggested by *Bowen*, Applicants suggest that the claimed structure of the present invention is neither identical to nor disclosed by the *Bowen* device. Therefore, *Bowen* cannot anticipate the present claimed invention.

Moreover, the allegedly prior art devices lack the functional characteristics of the claimed structure of the method claim in the present application. The cited device does not have the capability to accept multiple image intensifier tube types and to provide the proper gain for the type of tube used or selected.

Even if the *Bowen* patent incidentally showed a similar arrangement of parts, if that arrangement is neither claimed nor designed to perform the function of the present invention, neither patent can act as an anticipation.

35 U.S.C. § 103 Grounds for Rejection

The Examiner has also rejected (explicitly and implicitly) the Claims under 35 U.S.C. § 103(a) as being unpatentable over *Bowen*. Applicants respectfully traverse these rejections for the reasons discussed below.

Applicants' invention is directed toward solving the disadvantage that night vision devices heretofore were designed to accept a single type of image intensifier tube. Prior to the present invention the user of a night vision device had to replace the installed image intensifier tube with a tube of the same type, which may not always be readily available. Since night vision devices are often used by members of the military during operations and maintenance supplies may be limited, there is a need for the night vision device to be adapted to use another tube type that might be available.

Even if one were to insert (and there is no suggestion of doing so in *Bowen*) another image intensifier tube type in *Bowen's* night vision device, the night vision device would not have the independent capability to determine the type of replacement tube and establish the

proper electronic signals necessary for operation of that specific tube type different than the tube type being replaced.

By this structure Applicants are able to achieve the advantages which have hitherto not been achievable through any adaptation of the prior art. It is therefore believed to be clear that the particular structure of Applicants is extremely important and is not a mere matter of design.

It is improper to use hindsight having read the Applicant's disclosure to "pick and choose" among isolated prior art references to disparage the claimed invention. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Even where an invention is, as a whole, fully disclosed by a combination of prior art elements, such elements cannot be combined to defeat a patent as obvious unless the art teaches or suggests the desirability of making the combination. ASC Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 U.S.P.Q. 929 (Fed. Cir. 1984). Thus, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, U.S.P.Q.2d 1780 (Fed. Cir. 1992). Finally, it is the invention as a whole that is important. Focusing on the obviousness of substitutions and differences, instead of on the invention as a whole, is a legally improper way to simplify the often difficult determination of obviousness. Gillette Co. v. S. C Johnson & Son, Inc., 919 F. 2d 720, 16 U.S.P.Q. 1923 (Fed. Cir. 1990).

Independent Claim 1, as amended, recites the following elements, the most pertinent to this discussion being presented in bold type for the convenience of the Examiner:

1. An adaptive electrical circuit unit for use in a night viewer system of the type that includes an image intensifier tube and a compatible power source electrically connected to the image intensifier tube, the invention comprising:

a voltage gain detection circuit unit operably connected to the image intensifier tube for detecting **multiple selected types of image intensifier tubes** and producing an output gain signal appropriate to the **detected image intensifier tube** for controlling the gain of the detected image intensifier tube.

Applicant respectfully submits that *Bowen* does not disclose, teach, or suggest a means to detect multiple selected types of image intensifier tubes as recited by amended Claim 1 and Claim 11. Therefore, the Claims are not obvious in light of the cited art and Applicants respectfully submit that this rejection should now be withdrawn.

The Examiner should also remove the rejection because there is no teaching or disclosure in the prior art of record that would have suggested to the artisan the obviousness of providing a means to detect multiple selected types of image intensifier tubes.

In order to establish a prima facie case of obviousness, the prior art teachings must be sufficient to suggest making the substitution or modification necessary to make the claimed invention to one of ordinary skill in the art, In re Lulu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984), in the absence of applicant's own disclosure. See also, In re Laskowski, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398-99 (Fed. Cir. 1989) and Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). The motivation to make a specific structure

“is not abstract, but practical, and is always related to the properties or uses one skilled in the art would expect the [structure] to have, if made.”

In re Gyurik, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979). See also Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985)(“Critical inquiry is whether ‘there is something in the prior art as a whole to suggest the desirability, and, thus, the obviousness, of making the combination’”).

To the extent that these rejections are maintained by the Examiner, Applicants respectfully request that the Examiner specifically identify within the *Bowen* reference or other knowledge upon which such a continuing rejection is maintained.

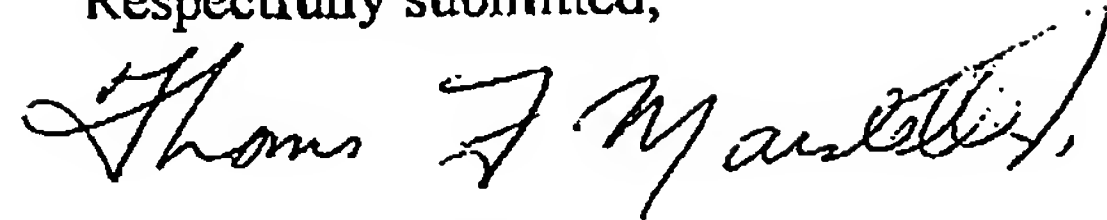
Dependent Claims 2-10 and 12-18 that depend from independent Claim 1 or 11 are also not made obvious by *Bowen* because they include the limitations of Claim 1 or 11 and add additional elements that further distinguish the art. Therefore, Applicants respectfully request that Claims 1-18 be allowed.

Conclusion

Applicants have now made an earnest attempt to place this case in condition for allowance. In light of the amendments and remarks set forth above, Applicants respectfully request reconsideration and allowance of Claims 1-18.

If there are matters which can be discussed by telephone to further the prosecution of this Application, Applicant invites the Examiner to call the attorney at the number listed below at the Examiner's convenience.

Respectfully submitted,



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